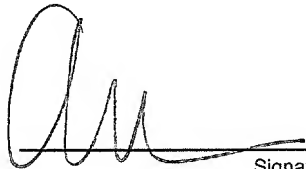


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		9314-60	
I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on <u>September 12, 2007</u> Signature <u>Candi L. Riggs</u> Typed or printed name <u>Candi L. Riggs</u>	Application Number	Filed	
	10/783,601	2/20/04	
	First Named Inventor	William O. Camp, Jr.	
	Art Unit	Examiner	
	2629	Hailemariam, E.	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Elizabeth A. Stanek	
<input checked="" type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number <u>48,568</u>		919-854-1400	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		September 12, 2007	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: William O. Camp Jr. *et al.*

Confirmation No.: 1548

Application No.: 10/783,601

Group Art Unit: 2629

Filed: February 20, 2004

Examiner: Hailemariam, Emmanuel

For: **THUMB-OPERABLE MAN-MACHINE INTERFACES (MMI) FOR
PORTABLE ELECTRONIC DEVICES, PORTABLE ELECTRONIC
DEVICES INCLUDING THE SAME AND METHODS OF OPERATING THE
SAME**

Date: September 12, 2007

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which was extended until further notice on January 10, 2006.

No fee or extension of time is believed due for this request beyond those requested in papers associated herewith. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefore. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action of June 12, 2007 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Claims 1, 6-13, 25, 26 and 29-32 stand rejected under 35 U.S.C. §103(a) as being anticipated by United States Patent Application Publication No. 2003/1037495 to Canova (hereinafter "Canova") in view of United States Patent No. 6,977,645 to Brosnan (hereinafter Brosnan). *See* Final Action, page 4. Claims 2, 14 and 18-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Canova in view of Brosnan and in further view of United

States Patent No. 6,570,596 to Frederiksen. *See* Final Action, page 6. Claims 3-5, 15-17 and 27-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Canova in view of Brosnan in further view of European Patent Application No. EP 1 113 385 A2 to Poloniemi *et al.* *See* Final Action, page 8. Applicants respectfully submit that many of the recitations of the pending claims are not met by the cited references for at least the reasons discussed herein and in Applicants' previously filed Request for Reconsideration of May 7, 2007.

Furthermore, Applicants submit that the Office Action of February 7, 2007 and/or the Final Action have not shown that the claims are obvious in view of the cited references. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of the independent Claims 1, 13 and 25.

Claim 1 recites:

A portable electronic device, comprising:
a housing;
a display integrated with the housing;
a thumb-operable input device positioned on a side of the housing;
an indicator on the display operatively associated with the thumb-
operable input device, the indicator being positioned on the display to highlight
and/or select menu items on the display responsive to input received at the
thumb-operable input device.

Independent Claims 13 and 25 include similar recitations to the highlighted recitations. Applicants respectfully submit that at least the highlighted recitations are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

The Final Action provides Canova as providing all of the recitations of Claim 1 except "the indicator on the display operatively associated with the thumb-operable input device (116)." *See* Final Action, page 4. However, the Final Action points to Brosnan as providing the missing teachings. *See* Final Action, page 4. Applicants respectfully disagree. In particular, the Final Action points to elements 111 and 119 of Figure 9 of Canova as teaching the thumb operable input device as recited in Claim 1. *See* Final Action, page 4. Element 119 of Canova is a switch "for activating and deactivating a text entry area." *See* Canova, paragraph 27. The switch is positioned on the side of the handheld computer 100 of Canova. However, as discussed in Canova, the switch 119 only activates or deactivates the text entry area, data must actually be entered using an alternative means, for example, using a stylus on the text entry area.

In stark contrast, Claim 1 recites "a thumb-operable input device positioned on a side of the housing" that allows one-handed operation of the handheld device. Nothing in Canova discusses one handed thumb operation of the handheld computer 100 of Canova. In fact, nothing in Canova discusses one-handed operation of the handheld device using the thumb. Accordingly, Claims 1, 13 and 25 and the claims that depend therefrom are patentable over the cited combination for at least these reasons.

Responsive to Applicants' arguments the Final Action points to paragraph 29 as supporting one hand free functionality of Canova. *See* Final Action, page 2. Paragraph 29 discusses the advantages of a "toggle mode" of Canova, which allows a user to enter data into an entry area on the computer 100 without constantly engaging the switch 119. *See* Canonva. Paragraph 29. The user of Canova still must actually enter data using an alternative means, for example, using a stylus on the text entry area, which is not done with the user's thumb.

The Final Action further points to paragraph 38 of Canova as teaching one handed thumb operation as recited in Claim 1. Paragraph 38 of Canova discusses depressing the switch 119 with a user's thumb to activate/deactivate the entry area 118 on the screen 114. *See* Canova, paragraph 38. Again, Canova discusses activation and/or deactivation of the entry area 119 using the switch 119. Data entry in Canova requires more than a user's thumb. Accordingly, Applicants respectfully submit that Claims 1, 13 and 25 and the claims that depend therefrom are patentable over the cited combination for at least these additional reasons.

As discussed above, the Final Action admits that nothing in Canova discusses the indicator on the display operatively associated with the thumb-operable input device as recited in Claim 1 and points to Brosnan as providing the missing teachings. *See* Final Action, page 4. The cited portion of Brosnan is a highlight bar 16 "moved by rubbing a finger against a motion detection device 20" positioned on a front of the housing as illustrated in Figure 1A of Brosnan. *See* Brosnan, column 4, lines 44-47. However, nothing in Brosnan discusses positioning the motion detection device 20 on a side portion of the housing so that it is thumb operable. Accordingly, nothing in either Canova or Brosnan discloses or suggests a thumb-operable input device positioned on a side of the housing or an indicator on the display operatively associated with the thumb-operable input device, the indicator being positioned on the display to highlight and/or select menu items on the display responsive to input received at the thumb-operable input device as recited in Claim 1. Thus, Claims 1, 13

and 25 and the claims that depend therefrom are patentable over the cited combination for at least these additional reasons.

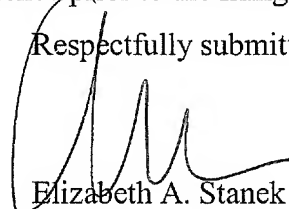
Responsive to Applicants arguments with respect to the positioning of the motion detection device 20 of Brosnan and the positioning thereof, the Final Action states:

...But Brosnan discloses a highlight bar(16, fig. 1A) where selected of menu is displayed (col. 4, line 34-44). The combined modified invention of Canova and Brosnan discloses a thumb-operable input device (119) and a highlight bar (16). The applicant argument is moot...

See Final Action, page 2. Applicants respectfully submit that the combination of Brosnan and Canova teaches a highlight bar 16 operated by a motion detection device 20 positioned on a front portion of the housing and a toggle switch 119 that can be positioned on the side of the housing and is configured to activate/deactivate the entry area 118 on the screen 114. Nothing in Canova, Brosnan or the combination thereof discloses or suggests positioning the motion detection device 20 of Brosnan so as to allow one handed thumb operation as recited in Claim 1. Thus, Applicants respectfully submit that this argument is not moot as suggested in the Final Action and that Claims 1, 13 and 25 and the claims that depend therefrom are patentable for at least the reason that the cited combination does not disclose or suggest all the recitations of these claims. Furthermore, as discussed in Applicants' Request for Reconsideration there is no motivation to combine the cited references as suggested in the Final Action.

Accordingly, for at least these reasons, Applicants respectfully submit that the Office Actions fail to show that the claims of the present application are obvious in view of the cited references and, therefore, requests that the present application be reviewed and that the rejections be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



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In re: William O. Camp, Jr. *et al.*
Serial No.: 10/783,601
Filed: February 20, 2004
Page 5 of 5

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on September 12, 2007.


Candi L. Riggs